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# SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1962.

## No. 558.

AERONAUTICAL COMMUNICATIONS EQUIPMENT, INC.,
*Petitioner,*

vs.

HELEN RUSSELL PIERCE, EXECUTRIX OF THE LAST WILL AND TESTAMENT OF GEORGE WASHINGTON PIERCE, DECEASED,
*Respondent.*

**RESPONDENT'S BRIEF IN PART SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT.**

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**RESPONDENT'S BRIEF IN PART SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT.**

The respondent respectfully submits that the petition for a writ of certiorari should be:

*Denied in toto* relating to patent 2,133,646, because there is no conflict of decisions, of the nature raised by the

Petition, with respect thereto[1]; and, with respect to patent 2,133,642[2],

*Denied*, relating to Question 2, presented on page 3 of the Petition,[3] but

*Granted*, relating to Question 1.[4]

The Petition should be granted, relating to this Question 1, for the reasons that:

First, three Courts of Appeals have arrived at four different and entirely contradictory answers to that Question 1;

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1. Not a single Court has ever passed on the issue, raised on page 10 of the Petition, relating to the Schelling patent 1,545,607.

2. In order to distinguish this patent 2,133,642 from the hereinafter-mentioned combination radio transmitting-and-receiving-system patent 1,789,496, it will be referred to hereinafter as the basic Pierce-oscillator element patent 2,133,642.

3. With respect to this Question 2, all that needs to be said here is that in neither the District Court nor the Court of Appeals for the Fifth Circuit did the petitioner call the attention of the Court to the issue relating to the Cady patent 1,472,583 that is now raised on pages 9-10 of the Petition. As is quite clear from its opening paragraph, on pages 1-2 of the Appendix accompanying the Petition, the Court of Appeals for the Fifth Circuit was of the understanding that the defendant was raising only one "fairly narrow issue that remains to be decided", and that that "remaining" issue was the issue of double patenting. The District Court, page 16 of the said Appendix, was similarly of the understanding that "the sole question for the Court", aside from the question of infringement, was only double patenting. Neither by motion for rehearing nor in any other way did the petitioner dispute the correctness of these understandings of the District Court and the Court of Appeals for the Fifth Circuit. That "remaining" or "sole" issue related only to double patenting, and it had nothing whatever to do with the issue that is now raised relating to the Cady patent 1,472,583.

4. For present purposes, the respondent will accept all the facts stated in Question 1, thus resolving the issues to a pure question of law.

Secondly, two of these three Courts of Appeals, upon subsequent occasions, has each adhered to its own answer to that Question 1, though in full knowledge of the fact that such answer is out of harmony with the answers of both the other two Circuit Courts of Appeals;

Thirdly, all four of these answers are still different from the answers arrived at by the District Courts of these various Courts of Appeals; and

Fourth, trials are being held up in a number of still additional District Courts in the hope that now, at last, this Court may be willing finally to inform the judges thereof as to which of the many different and contradictory answers to that Question 1, arrived at by the various District Courts and Courts of Appeals, is correct.

As a fifth consideration, moreover, it is believed that the Patent Office also (as well as many thousands of patentees of pairs of patents of the nature hereinafter discussed) would desire to have the correct answer to that Question 1, in order that it may learn, from this Court, whether, in the past, it has been right or wrong in granting patents that have been subject to so many different criticisms by so many different District Courts and Courts of Appeals, and in order to guide itself with respect to whether or not to continue to grant future such patents.

**Certiorari Should Also Be Granted, However, in Pierce v. Allen B. DuMont Laboratories, Inc., No. 138, October Term, 1962, Appendix H, Annexed to the Petition.**

Certiorari should also be granted, however, in *Pierce v. Allen B. DuMont Laboratories, Inc.*, 1961, 3 Cir., 297 F.2d 323, No. 138, October Term, 1962, Petitioner's Appendix H, because it is one of the three Courts of Appeals before-mentioned as being in conflict with each of the other two Courts of Appeals.

**The Background.**

As a background to an understanding of these various contradictory decisions by the said Courts of Appeals and District Courts, it should be stated that the invention of the before-mentioned basic patent 2,133,642 related to a new electronic oscillator, which has since become known all over the world as the Pierce oscillator. The inventor was Dr. George Washington Pierce, since deceased, but, at the time, a professor of physics at Harvard University. He was one of the few survivors of that old breed, now unhappily driven out of existence by adverse court decisions, of what might be described as the "lone" inventor, not attached to a corporation. Dr. Pierce made also a number of additional inventions, in a number of different fields, and his inventions materially aided our nation in the prosecution of two world wars.

Among Dr. Pierce's inventions that should be mentioned at this point was a combination radio transmitting-and-receiving system, covered by his combination patent 1,789,496. This combination patent 1,789,496 issued and, therefore, expired, before the basic Pierce-oscillator patent 2,133,642. The invention of this combination radio-transmitting-and-receiving system could be practiced, optionally or preferably, as recited by claim 2 of the combination patent 1,789,496, with the aid of two Pierce oscillators as two elements of the combination, one at the transmitting end and the other at the receiving end of the system; but it could also be practiced, as recited by claims 1 and 3 of the combination patent 1,789,496, without the aid of any Pierce oscillators, at all, merely by using prior-art oscillators as elements of the combination. (Attention may be invited to the description, by the Court of Appeals for the Fifth Circuit, at the very top of page 2 and the top of page 4 of the said Appendix.)

After the close of the second world war (though not before), Dr. Pierce entered a number of civil actions for infringement of his patents; but not of the combination patent 1,789,496, which had meantime expired. Nine such civil actions are referred to by the Court of Appeals for the Fifth Circuit at the very bottom of page 4 of the said Appendix, and they are listed in *Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 1937, D.C. Del., 156 F. Supp. 237, 238, footnote 1.

The first of these civil actions to reach the stage of a court decision was *Pierce* v. *American Communications Company, Inc.*, 1953, D.C. Mass., 111 F. Supp. 181. In that case, Judge Ford held that there was no double patenting[5] between the basic Pierce-oscillator element patent 2,133,642 and the combination radio-transmitting-and-receiving-system patent 1,789,496, because the inventions covered by the two patents (one, the Pierce oscillator, and the other, the combination radio transmitting-and-receiving system) were not the same.[6] Judge Ford held also that the Pierce oscillator, in the language of footnote 2 of the decision of the Court of Appeals for the Fifth Circuit (quoted at the bottom of page 11 of the said Appendix) constituted a "very

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5. By the term "double patenting" is meant that two patents for *the same invention* have been issued to the same inventor, at different times, and that the later of the two patents is therefore invalid, because the Commissioner of Patents has no authority, after granting one patent to an inventor, to extend the term of the monopoly granted thereby by issuing to the same inventor a later or second patent for the *same invention*.

6. The Court of Appeals for the Fifth Circuit is in full agreement, page 8 of the Appendix accompanying the Petition:

> "obviously the combination patent 1,789,496, contained many elements in the transmitting and receiving system that were not 'contained' in patent 2,133,642, which was purely and simply a patent on the oscillator".

substantial contribution made to the art".[7] Judge Ford held further that the public did not have the right to use the combination radio-transmitting-and-receiving-system invention covered by the said claim 2 of the combination patent 1,789,496, even though that combination patent had expired, because the use of the two Pierce oscillators, recited as two elements of the combination covered by that claim 2, would result in infringement of the basic Pierce-oscillator element patent 2,133,642.

**The Four Contradictory Decisions of the Said Three Courts of Appeals**

The first of the before-mentioned four contradictory decisions was by the Court of Appeals for the First Circuit, *American Communications Company, Inc.*, v. *Pierce*, 1953, 1 Cir., 208 F.2d 763, certiorari denied 1954, 347 U.S. 944, rehearing denied 1954, 347 U.S. 970, Petitioner's Appendix E. This decision vacated Judge Ford's judgment, but without disturbing Judge Ford's holding that there was no double patenting. As a matter of fact, the Court of Appeals for the First Circuit distinctly held, as appears from page 49, lines 8-10, of the said Appendix, that it was not even necessary to decide whether there was or was not double patenting. In that case, therefore, the Court of Appeals for the First Circuit held merely that, without at all invalidating the basic Pierce-oscillator element patent 2,133,642, it would refuse to enforce it against members of the public who desired to use the combination radio

7. Judge Ford considered all the prior art that the defendant in that Civil Action cited, including the before-mentioned Cady patent 1,472,583, discussed on pages 9-10 of the Petition. As appears from the top of page 4 and page 28 of the Appendix accompanying the Petition, the Court of Appeals for the Fifth Circuit has clearly understood, from the very beginning, that this Cady oscillator is not the same as the Pierce oscillator.

transmitting-and-receiving system that was covered by the said claim 2 of the combination patent 1,789,496. The reason for this holding was that the combination patent 1,789,496 had expired, and that the public has the right to use the invention of an expired patent.[8] As quoted at the bottom of page 7 of the Petition, the Court of Appeals for the First Circuit held:

> "We cannot now extend that monopoly [of the combination radio transmitting-and-receiving system covered by claim 2 of the earlier expired patent 1,789,496] under the mantle of patent No. 2,133,642."[9]

This constituted the first answer, by the Court of Appeals for the First Circuit, to the Petitioner's Question 1, presented on page 3 of the Petition.

At a later time, however, the Court of Appeals for the First Circuit appeared to realize that there was something wrong with reasoning to the effect that a basic patent, though valid, could nevertheless be refused enforcement. In the next case, against a different defendant, that came before it, therefore, the Court of Appeals for the First Circuit decided to answer that same Question 1 quite differently. That different answer was to hold the basic Pierce-oscillator element patent 2,133,642 invalid for double

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8. Judge Ford had held, as before stated, page 6, *supra*, that the public did *not* have such right, because the combination radio transmitting-and-receiving system covered by the said claim 2 of the combination patent 1,789,496 included, as two elements of the combination, two Pierce oscillators, and the use of these two Pierce oscillators would constitute infringement of the basic Pierce-oscillator element patent 2,133,642.

9. This was clearly *not* a holding that the basic Pierce-oscillator element patent 2,133,642 was invalid for double patenting. Such a holding would have required a ruling to the effect that the term of the monopoly *of the basic Pierce-oscillator element patent 2,133,642* had been extended, *and there was no such ruling.*

patenting, *Pierce* v. *Hewlett Packard Company*, 1955, 1 Cir., 220 F.2d 531, certiorari denied 1955, 350 U.S. 833, rehearing denied 1955, 350 U.S. 897, Petitioner's Appendix F.[10] Since an invalid patent can not be infringed, that holding of invalidity, for double patenting, served equally well to permit the public to use the invention of the said claim 2 of the expired combination patent 1,789,496, without infringing the basic Pierce-oscillator element patent 2,133,642.

It should be observed, however, that, by this second answer to the said Question 1, the Court of Appeals for the First Circuit did *not* hold that the two inventions (one, the Pierce oscillator, covered by the basic patent 2,133,642, and the other, the combination transmitter-and-receiving system, covered by the combhination patent 1,789,496) were the *same invention*.[11] This second answer, relating to double patenting, was based upon the ground, as appears from the top of page 53 of the said Appendix, that the Pierce oscillator constituted an "essential element"[12] of the combination radio transmitting-and-receiving system covered by the said claim 2 of the combination patent 1,789,496.

A third answer to the said Question 1 was given in *Pierce* v. *Aeronautical Communications Equipment, Inc.*, 1958, 5 Cir., 255 F.2d 458, Petitioner's Appendix D. In this third answer, the Court of Appeals for the Fifth Circuit, "notwithstanding the decision of a court of a different cir-

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10. The Court of Appeals for the First Circuit, as will appear more fully hereinafter, page 11, later adhered to this holding of double patenting in *Pierce* v. *American Communications Company, Inc.*, 1960, 1 Cir., 280 F.2d 278, certiorari denied 364 U.S. 902, Petitioner's Appendix G.

11. Attention is invited to the meaning of the term "double patenting", given in footnote 5, *supra*.

12. The word "essential" is included in the said Question 1.

cuit for which we have the highest respect" (bottom of page 2 of the said Appendix), refused to agree either that a valid basic patent should not be enforced, as the Court of Appeals for the First Circuit had held, in its said American Communications Company, Inc., opinion, or that there was any double patenting, as the same Court of Appeals for the First Circuit had held, in its Hewlett-Packard Company opinion. The Court of Appeals for the Fifth Circuit accordingly held that the basic Pierce-oscillator element patent 2,133,642 was both valid and enforceable.

The fourth of the said four contradictory answers to the said Question 1 was *Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 1961, 3 Cir., 297 F.2d 323, No. 138, October Term, 1962, Petitioner's Appendix H, page 3, *supra*. In that case, the Court of Appeals for the Third Circuit repudiated all three holdings discussed above: namely, the two holdings of unenforceability and double patenting of the Court of Appeals for the First Circuit; and also the holding of the Court of Appeals for the Fifth Circuit to the effect that the basic Pierce-oscillator element patent 2,133,642 was both valid and enforceable. That fourth answer was that the basic Pierce-oscillator element patent 2,133,642 must, indeed, be held to be invalid; not, however, for double patenting;[13] but for the entirely different reason[14] that such hold-

13. The Court of Appeals for the Third Circuit apparently feared that a holding of double patenting could not "be squared with recent decisions of the Supreme Court", see page 89 of the Appendix.

14. This tendency of the Courts to destroy patents, if not for one reason then for another, would appear to be inconsistent with the policy of Article I, Section 8, of the Constitution "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." In this particular instance, after Dr. Pierce's inventions had greatly helped us to win two world wars, he thereafter refused to make any more inventions.

ing of invalidity appeared to be the only way that was now left by which to protect the right of the public to use the invention covered by the said claim 2 of the expired combination patent 1,789,496, without infringement of the basic Pierce-oscillator element patent 2,133,642. As appears from the bottom of page 89 of the said Appendix, the Court of Appeals for the Third Circuit held

> "that it is the extension of this monopoly [of the invention of the combination radio transmitting-and-receiving system patent 1,789,496, *not* the monopoly of the invention of the Pierce oscillator, covered by the basic Pierce-oscillator patent 2,133,642] beyond its proper seventeen years term which invalidates the generic patent."

Like the Court of Appeals for the First Circuit, however, the Court of Appeals for the Third Circuit, did *not* hold that the invention of the Pierce oscillator, covered by the basic patent 2,133,642, and the invention of the combination radio-transmitting-and-receiving system, covered by the combination patent 1,789,496, were the *same invention*. As appears from the top of page 87 of the Petitioner's Appendix, the Court of Appeals for the Third Circuit based its holding of invalidity of the basic Pierce-oscillator patent 2,133,642 upon the same "essential-element" ground upon which the Court of Appeals for the First Circuit (see page 8, *supra*) had based its Hewlett-Packard Company opinion (though not its American Communications Company, Inc., opinion). This decision of the Court of Appeals for the Third Circuit, however, to the effect that a later element patent may be held invalid, not for double patenting, and not for any other reason than merely for the purpose of preventing the so-called extension of the monopoly of an earlier combination patent, appears to be absolutely brand-

new law, which, of course, it is the function of Congress, and not the Courts of Appeals, to enact[15].

It may not be out of place to add that, as appears from the bottom of page 90 of the Appendix accompanying the Petition, the Court of Appeals for the Third Circuit appreciated the fact that it was dealing with "difficult and doubtful points of law."

It is respectfully submitted that this Court ought to put an end to the difficulty and the doubt.

**The Courts of Appeals of the First and Fifth Circuits Each Continues to Insist That It Is Right, and the Other Courts Wrong.**

The story is not, however, quite yet complete. There is more to tell about further decisions of the Courts of Appeals for the First and Fifth Circuits.

The Court of Appeals for the First Circuit was afforded an opportunity to reconsider its Hewlett-Packard Company holding of double patenting, in view of the disagreement therewith of the Court of Appeals for the Fifth Circuit. It refused, however, to do so, *Pierce* v. *American Communications Company, Inc.*, 1960, 1 Cir., 280 F.2d 278, certiorari denied 364 U.S. 902. Petitioner's Appendix G, footnote 10, *supra*.

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15. It may be of interest to observe that, in the Third Circuit, the District Court, in a first opinion, *Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 1958, D.C. Del., 166 F. Supp. 332, approved the before-mentioned decision of the Court of Appeals for the Fifth Circuit 255 F.2d 458, page 8, *supra*; but, in a later opinion, 178 F. Supp. 84, 91, it receded from this position, and, frankly placing itself "at variance with the opinion of the Fifth Circuit Court of Appeals", held double patenting. The Court of Appeals for the Third Circuit, however, as has already been made plain, disagreed with both of these two holdings of its District Court.

Thereupon, the Court of Appeals for the Fifth Circuit was afforded an opportunity to aline itself either with the Court of Appeals for the First Circuit or the Court of Appeals for the Third Circuit, but it likewise adhered to its original opinion. In the case that is now before this Court, upon the present Petition, the Court of Appeals for the Fifth Circuit has agreed with the Court of Appeals for the Third Circuit in refusing to follow the Court of Appeals for the First Circuit, either in the American Communications Company, Inc., opinion, as to unenforceability, or the Hewlett-Packard Company opinion, as to double patenting. It has likewise, however, refused to follow the holding of the Court of Appeals for the Third Circuit to the effect that the basic Pierce-oscillator element patent 2,133,642 must be held to be invalid, as the only way left in which to assure the right of the public to use the invention covered by the said claim 2 of the expired combination patent 1,789,496, without infringing the basic Pierce-oscillator element patent 2,133,642.

The Court of Appeals for the Fifth Circuit has held also, disagreeing with the Courts of Appeals of both the First and Fifth Circuits, that it is immaterial whether the Pierce oscillator was or was not an "essential element" of the combination radio transmitting-and-receiving system covered by the said claim 2 of the combination patent 1,789,496. For, even assuming such to be the fact, that does not make the invention of the Pierce oscillator the *same invention* as the invention of the combination radio transmitting-and-receiving system. There could not, therefore, be any double patenting.

The Court of Appeals for the Fifth Circuit was also unable to find any precedent for invalidating the basic patent 2,133,642 merely for the purpose of enabling the public to continue to use, without infringement, the com-

bination radio transmitting-and-receiving system covered by the said claim 2 of the combination patent 1,789,496.

In the case that is now before this Court upon the present Petition, therefore, the Court of Appeals for the Fifth Circuit has adhered to its earlier holding, page 8, *supra*, to the effect that the basic patent 2,133,642, covering the Pierce oscillator, was not invalid for double patenting, or for any other reason, and that it is enforceable.

**Reasons for Granting the Writ, Insofar As Question 1, Relating to the Basic Pierce-Oscillator Element Patent 2,133,642, Is Concerned.**

There now, therefore, is irreconcilable conflict between at least three Courts of Appeals as to the correct answer that should be given to the Petitioner's Question 1. The Court of Appeals for the First Circuit has been afforded an opportunity to agree with the Answer of the Court of Appeals for the Fifth Circuit, and has refused to do so. The Court of Appeals for the Fifth Circuit has been afforded an opportunity to agree with any of the three additional answers of the Courts of Appeals for the First and Third Circuits, and has likewise refused to do so. And the Court of Appeals for the Third Circuit has refused to adopt any of the answers of either the Court of Appeals for the First Circuit or the Court of Appeals for the Fifth Circuit.

Unless this Court will tell the Courts of Appeals and the District Courts which of the four contradictory answers to the said Question 1, given by these three Courts of Appeals, is correct, therefore, there will continue to be chaos.

There are a number of civil actions still pending in various District Courts the prosecution of which has been

held up, pending a final decision as to whether the basic Pierce-oscillator element patent 2,133,642 is or is not valid and is or is not enforceable.

The respondent will be helpless to prosecute these still-pending civil actions, and the District Courts will be equally helpless to permit her to do so, until guidance is obtained from this Court.

It is not, furthermore, the District Courts and the parties litigant in these particular actions who alone desire the guidance of this Court. There are thousands and thousands of pairs of patents already issued, in which one patent of each pair covers an element of a combination of the other patent of the pair. There can be no question but that the Patent Office would likewise eagerly desire to be informed, by this Court, whether or not to continue to grant pairs of patents of this nature.

The Courts of Appeals for the First, Third and Fifth Circuits have all presumably been influenced, in their different and contradictory answers to the said Question 1, by considerations as to whether it is of more to the interest of the country to throw inventions open to public use or to encourage invention.

It is respectfully submitted that, especially in this era of foreign aggression, it is certainly not in our best interest for this Court to sit idly by, while permitting the lower courts to continue to discourage our inventors.

It is therefore respectfully submitted that the petition for certiorari should be:

*Denied in toto* as to patent 2,133,646;

*Denied* as to Question 2, relating to patent 2,133,642; and

*Granted* as to Question 1, relating to patent 2,133,642.

It is further submitted, however, that certiorari should be granted, not only in this case, but also in *Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 1961, 3 Cir., 297 F.2d 323 No. 138, October term, 1962, pages 3-9, *supra*.

Respectfully submitted,

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